

REMARKS

Non-Compliant Amendment

The examiner has pointed out that amendments to the claims in a reissue application such as this must be made pursuant to 37 C.F.R. § 1.173, and not § 1.121(b) as was done in
5 the original of this amendment mailed on March 18, 2005. Accordingly, this Revised Amendment is submitted to replace the March 18 amendment.

Subparagraph (b)(2) of § 1.173 does not require a listing of all pending claims, but only the text of each claim being **changed or added** by the amendment. Accordingly, since no amendments are made herein to pending claims 1-15, 17, 24 or 29, they are not included
10 in the amendments to the claims beginning on page 3 of this paper.

Pursuant to MPEP § 1453, all claims presented in a subsequent amendment, such as this, must be made relative to the patent specification in effect as of the date of the filing of the reissue and not relative to any prior amendment. In this case, the specification in effect as of the date of the filing of the reissue included 15 claims. A preliminary amendment was
15 filed with the reissue application amending claims 2 and 9, and adding new claims 16-32. The present amendment further amends several of claims 16-32, and also adds new claims 33-75. The fees for all of these claims were paid with the original amendment mailed on March 18, 2005.

No further amendments are made to claims 1-15, 17, 24 or 29.

20 **With regard to claims 16, 18-23, 25-28 and 30-32,** because all of the text of these claims is “new” (even if amended herein) all of that text must be underlined in the

amendments beginning on page 3 of this paper, pursuant to 37 C.F.R. § 1.173(d) and MPEP § 1453. This underlining may make it difficult for the examiner to distinguish the present amendments from any prior ones. Thus, for the convenience of the examiner, a separate listing of amended claims 16-32 is attached hereto as **Exhibit A** which reflects only the
5 differences between these claims and their immediately prior versions.

RESPONSE TO OUTSTANDING OFFICE ACTION

Recapture under 35 U.S.C. § 251

The examiner has rejected claims 16-18 and 20-28 under 35 U.S.C. § 251 as being
10 an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. The examiner identifies three areas of potential recapture revolving around base claims 16 and 18. In response, claims 16 and 18 as amended herein are not believed to recapture surrendered subject matter.

In order for an improper recapture to occur, the reissue claim must be as broad as or
15 broader than a cancelled or amended claim in an aspect germane to a prior art rejection. *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997).

With respect to the first potential recapture area, claims 16 and 18 are amended herein to reflect the limitation of the pad extending “beyond” the base panel. However, there is no recapture as to the other two areas identified by the examiner.

20 With respect to the second area, the limitation requiring the pad to fit “on top of” the cover introduced in the amendment file 2/5/01, the applicant points out that new claim 13

was also introduced in the 2/5/01 amendment without this limitation.¹ Claim 13 included the limitation of the pad extending beyond the base panel, but did not include either of the other two areas of potential recapture (i.e., the pad “on top of” the cover, nor the “gap” between the walls, discussed next). In fact, claim 13 did not include any cover element at all, much less a pad fitting on top of it. A separate dependent claim (15) introduced at the same time included the cover and the “on top of” limitation. Thus, the limitation of the pad fitting on top of the cover was not present in a broad allowed claim (13) containing no other limitations germane to the office action. Here, amended claim 18 is narrower than claim 13 because it includes the additional limitation of a cover, not present in claim 13. Claims 16 and 18 have also been amended, as mentioned above, to include the limitation of the pad “extending beyond” the base. Accordingly, there is no recapture of the “on top of” limitation in amended claims 16 and 18 herein.

Finally, with respect to the third limitation concerning the “gap” between the second side wall and the end wall, it must be remembered that there were two distinct embodiments of the support unit of the invention: (a) a first embodiment having a base, a single end wall and two side walls (claims 1-7, 13-15), and (b) a second embodiment having a base, two end walls, a complete sidewall, and a partial sidewall (claims 8-12). The limitation of the “gap” between the partial side wall and the second end wall is only applicable to the second embodiment, and is completely missing from the other claims directed to the other embodiment, particularly claims 1 and 13. Thus, this limitation was not germane (nor even

¹ Claim 13 was later allowed with minor grammatical changes.
Serial No. 10/716,247

possible) in the first embodiment to which claims 16 and 18 are also drawn. Thus, the absence of this limitation from claims 16 and 18 is not a recapture of surrendered subject matter.

Claim Objections

5 The examiner has objected to claim 19 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 19 has been so amended, and is now believed to be in condition for allowance.

 The examiner has objected to claim 23 because “said cover extension” lacks
10 antecedent basis. In response, claim 21 (from which claim 23 depends) has been amended to depend from claim 19, providing proper antecedent basis. Since claim 19 is now believed to be in condition for allowance, claims 21 and 23 are also believed to be in condition for allowance.

 The examiner has objected to claim 26 because “said inside surfaces” lacks
15 antecedent basis. This claim has been amended to provide such basis.

 Finally, the examiner has objected to the phrase “the left edge” in claim 31. This phrase has been deleted.

Rejection Under 35 U.S.C. § 102(b)

 The examiner has rejected claim 31 under 35 U.S.C. § 102(b) as being anticipated
20 by Lerner (U.S. 3,336,608). In response, the applicant has amended claim 31 to include the limitation of the pad extending beyond the base panel, a feature not disclosed in Lerner.

Rejections Under 35 U.S.C. § 103(a)

The examiner has rejected claims 16-18, 21 and 26-27 under 35 U.S.C. § 103(a) as being unpatentable over Antosko (US 5,115,524) in view of Linge (US 5,675,853). As indicated previously, claims 16-17 have been cancelled. Claim 18 has been amended to include the limitation of the pad extending beyond the base panel. Neither Antosko nor Linge disclose or teach providing such an extended pad. Thus, claim 18 is believed to be in condition for allowance. Claim 19 was only objected to, and has been amended to include the limitations of base claim 18. Claims 21 and 26-27 have been amended to depend from claim 19. Thus, these claims are believed to be in condition for allowance.

10 The examiner has rejected claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Antosko and Linge in further view of Butler III (US 5,551,108). In response, the applicant has amended claim 25 to depend from allowable claim 19.

15 The examiner has rejected claim 28 under 35 U.S.C. § 103(a) as being unpatentable over Antosko and Linge in further view of Dishart (US 3,269,621). In response, the applicant has amended claim 28 to depend from allowable claim 19.

20 The examiner has rejected claims 16-18, 21, 26-27 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Lerner (US 3,336,608) in view of Linge (US 5,675,853). As indicated previously, claims 16, 18 and 31 have been amended to include the limitation of the pad extending beyond the base panel. Neither Lerner nor Linge disclose or teach providing such an extended pad. Thus, claims 16 and 18 are believed to be in condition for allowance. Claim 19 was only objected to, and has been amended to include the limitations

of base claim 18. Claims 21 and 26-27 have been amended to depend from claim 19. Thus, these claims are believed to be in condition for allowance.

The examiner has rejected claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Lerner and Linge in further view of Butler III (US 5,551,108). In response, the applicant has amended claim 25 to depend from allowable claim 19.

The examiner has rejected claim 28 under 35 U.S.C. § 103(a) as being unpatentable over Lerner and Linge in further view of Dishart (US 3,269,621). In response, the applicant has amended claim 28 to depend from allowable claim 19.

New Claims

New claims 33-75 are added by this amendment. No new matter has been introduced with these claims, and the antecedent basis for each claim is identified below.

Claim 33 is directed toward an embodiment of the invention having a fabric cover that extends beyond the opposite end of the base panel. Antecedent basis is found in the specification at column 4, lines 20-27 and Fig. 8. Claim 34 depends from claim 33 an a pad placed over the cover. Antecedent basis is found in the specification at column 4, lines 27-33.

Claim 35 is directed toward an embodiment of the invention having a plurality of openings on the back of the base panel for receiving suction cups, the cover having openings corresponding thereto. Antecedent basis is found in the specification at column 4, lines 42-47.

Claim 36 is directed toward an embodiment of the invention having a pair of slots for receiving a securement belt, the cover having openings corresponding thereto. Antecedent basis is found in the specification at column 4, lines 48-49.

5 Claim 37 is directed toward an embodiment of the invention having a night light in the end wall, the cover having a corresponding opening. Antecedent basis is found in the specification at column 4, lines 61-62.

Claims 38-39 are dependent on allowed claim 29 and includes slots for receiving a securement belt, and openings in the cover for the slots. Antecedent basis is found in the specification at column 4, lines 48-49.

10 Claim 40 is dependent on allowed claim 30 and includes openings in the cover for the straps. Antecedent basis is found in the specification at column 5, lines 9-15.

Claim 41 is dependent on allowed claim 29 and includes outside pockets. Antecedent basis is found in the specification at column 4, lines 51-55.

15 Claim 42 is dependent on allowed claim 29 and includes outside pockets. Antecedent basis is found in the specification at column 4, lines 56-60.

Claim 43 is dependent on allowed claim 29 and includes a night light. Antecedent basis is found in the specification at column 4, lines 61-62.

Claim 44 is dependent on claim 43 and includes openings in the cover for the night light. Antecedent basis is found in the specification at column 4, lines 61-62.

20

Claim 45 is dependent on allowed claim 29 and includes a removable wedge for supporting an infant's body. Antecedent basis is found in the specification at column 3, lines 15-19.

5 Claim 46 is dependent on allowed claim 29 and includes a removable cover for the pad. Antecedent basis is found in the specification at column 2, lines 4-6.

Claim 47 is dependent on allowable claim 19 and includes a securing strap. Antecedent basis is found in the specification at column 5 lines 9-11, and col. 3, lines 5-7.

Claim 48 is dependent on allowable claim 19 and includes an opening in the cover. Antecedent basis is found in the specification at column 2 lines 65-66.

10 Claim 49 is dependent on allowable claim 19 and includes a zipper. Antecedent basis is found in the specification at column 2 lines 57-58, and column 4, lines 35-37.

Claim 50 is dependent on allowable claim 19 and includes interengaging hooks and loops (Velcro). Antecedent basis is found in the specification at column 4 lines 35-37.

15 Claim 51 is dependent on allowable claim 19 and includes a night light. Antecedent basis is found in the specification at column 3, lines 8-10, and column 4, lines 61-62.

Claim 52 is dependent on claim 51 and refers to openings for the night light. Antecedent basis is found in the specification at column 3, lines 8-10, and column 4, lines 61-62.

20 Claim 53 is dependent on allowable claim 19 and includes a removable wedge for supporting an infant's body. Antecedent basis is found in the specification at column 3, lines 15-19.

(1) the independent claims fee of \$700 for the 7 new independent claims in excess of three at \$100 each (37 C.F.R. § 1.16(i)), created or added by this amendment; and

(2) a fee of \$1075 for the 43 claims in excess of those already paid for at \$25 each (37 C.F.R. § 1.16(j)).

5

Authorization to Charge Additional Fees

The Office is hereby authorized to charge deposit account number 502429 for any additional fees that may be required by this paper.

In view of the above, it is submitted that all claims are in condition for allowance. Allowance of the claims at an early date is solicited.

10

The examiner is encouraged to contact the undersigned by telephone to resolve any outstanding issues concerning this application.

Dated: May 18, 2005

Respectfully Submitted,

15

By



MARK D. MILLER

No. 32,277

Customer No. 25265

Kimble, MacMichael & Upton

5260 N. Palm Ave., Ste. 221

Fresno, California 93704

(559) 435-5500

20

924102.25.rev.sied.reissue.amend.one.1

25

Exhibit A

(Amendments to Claims 16-33 relative to Immediately Prior Versions)

16. (Once Amended) A portable infant bed comprising a generally rectangular flat base panel having two parallel longitudinal sides and two parallel ends, an end wall
5 perpendicularly attached at one end of said panel, a pair of parallel side walls perpendicularly attached along a portion of the two longitudinal sides of said panel and to said end wall to form an integrated support unit, [a fabric cover covering the support unit,] and a generally rectangular pad that fits between the side walls and extends outwardly beyond said base panel [on top of the cover].

10

17. (Not amended) The infant bed of claim 16 wherein said base panel has a generally square shape.

18. (Once Amended) A portable infant bed comprising:

15 a. an integrated support unit comprising a generally rectangular flat base panel having two parallel longitudinal sides and two parallel ends, an end wall perpendicularly attached at one end of the base panel, and a [pair of parallel] first side wall[s] perpendicularly attached [to] along one of the two longitudinal sides of the base panel and to the end wall, and a second side wall perpendicularly attached along the other longitudinal
20 sides of the base panel and to the end wall;

b. a fabric cover fitting over the base panel, side walls and end wall of the unit; and

c. a generally rectangular pad that fits between said side walls and extends outwardly beyond said base panel.

19. (Once Amended) [The infant bed of claim 18 wherein] A portable infant bed
5 comprising:

a. an integrated support unit comprising a generally rectangular flat base panel having two parallel longitudinal sides and two parallel ends, an end wall perpendicularly attached at one end of the base panel, a first side wall perpendicularly attached along one of the two longitudinal sides of the base panel and to the end wall, and a second side wall
10 perpendicularly attached along the other longitudinal sides of the base panel and to the end wall;

b. a fabric cover fitting over the base panel, side walls and end wall of the unit, said cover [extends] extending beyond the opposite end of the base panel [,] ; and

c. a generally rectangular pad that fits between said side walls, said pad [extends]
15 extending beyond the base panel adjacent to the extended cover.

20. (Once Amended) The infant bed of claim [18] 19 wherein said base panel has a generally square shape.

21. (Once Amended) The infant bed of claim [18] 19 wherein at least one handle is provided on said cover.

22. (Once Amended) The infant bed of claim 19 wherein a [fabric] hinge is provided in said extended cover at a point beyond said base panel.

5 23. (Once Amended) The infant bed of claim 21 wherein a pair of handles are provided, one handle being in the vicinity of said end wall and the other on said cover extension, and a [fabric] hinge is provided in said cover at a point beyond said base panel.

24. (Not amended) The infant bed of claim 22 wherein a means for securing said
10 bed against itself is provided on said cover.

25. (Once Amended) The infant bed of claim [18] 19 wherein each of said side walls has an inside surface and an outside surface covered by said cover, and a plurality of pockets are provided on said cover on said outside surfaces.

15

26. (Once Amended) The infant bed of claim [18] 19 wherein each of said side walls has an inside surface and an outside surface covered by said cover, and a plurality of pockets are provided on said cover on said inside surfaces.

20 27. (Once Amended) The infant bed of claim [18] 19 wherein a plurality of slots are provided in said end wall for receiving a securement belt.

28. (Once Amended) The infant bed of claim [18] 19 wherein a plurality of openings are provided on the back of said base panel for receiving suction cups.

5 29. (Not amended) A portable infant bed comprising:

a. an integrated support unit including a generally rectangular flat base panel having two parallel longitudinal sides and two parallel ends, a first end wall perpendicularly attached at one end of said panel, a second end wall perpendicularly attached at the opposite end of said panel, a first side wall perpendicularly attached along one of the two longitudinal sides of said base panel and to each of said end walls, and a second partial side wall perpendicularly attached along a portion of the opposite longitudinal side of said base panel and to one of said end walls, leaving a gap between said second side wall and said other end wall ;

b. a fabric cover fitting over the base panel, side walls and end walls of said unit; and

c. a generally rectangular pad that fits inside said end walls and said side walls adjacent to said cover.

30. (Once Amended) The infant bed of claim 29 wherein at least one strap is [a plurality of straps are] provided on said first side wall for securing said unit in place.

31. (Once Amended) A portable infant bed comprising:

a. a generally rectangular flat base panel having two parallel longitudinal sides and two shorter parallel ends;

b. a end panel perpendicularly attached to one end of said base panel;

5 c. a first side panel perpendicularly attached along one of the two longitudinal sides of said base panel and to said end panel [to form a first corner];

d. a second side panel perpendicularly attached along the opposite longitudinal side of said base panel and to [the left edge of] said end panel [to form a second corner]; and

10 e. a generally rectangular pad for placement on said base panel between said side panels, [one] a proximal end of said pad abutting against said end panel said pad configured to have a proximal end abut said end panel and a distal end extend outwardly from said base panel.

15 32. (Once Amended) The infant bed of claim 31 wherein a fabric cover is provided that fits over the base panel, side panels and end panel of said bed such that said pad fits between said side panels on top of [adjacent to] said cover.